

REMARKS

I. Summary of the Office Action

Claims 1-6, 30, 31, 33-38, 40-44, 46, and 47 are pending in the above-identified patent application. Of those, claims 1-6 and 30 have been withdrawn from further consideration as being drawn to a non-elected invention.

Claims 33-38 were objected to as being dependent upon a rejected base claim, but were indicated to be allowable if rewritten in independent form to include all the limitations of the base claim and any intervening claims. (Office Action, p. 6, ¶ 9).

Claim 42 has been objected to under 37 C.F.R. § 1.75 as being a substantial duplicate of claim 41. (Office Action, p. 2, ¶ 2).

Claim 40 has been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. (Office Action, pp. 2-3, ¶ 3).

Claim 31 has been rejected under 35 U.S.C. § 102(b) as being anticipated by European Patent Publication No. EP 1 022 403 to Capelain (“Capelain”) (Office Action, p. 3, ¶ 4); Australian Patent No. 55,877 to Lieber (“Lieber”) (Office Action, pp. 3-4, ¶ 5); and U.S. Patent No. 6,003,279 to Schneider (“Schneider”) (Office Action, pp. 4-5, ¶ 6). Claims 40-44 and 47 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,053,353 to Miller (“Miller”). (Office Action, pp. 5-6, ¶ 7).

Claim 46 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Miller. (Office Action, p. 6, ¶ 8).

II. Summary of Applicants’ Reply

Applicants appreciate the Examiner’s indication that claims 33-38 would be allowable if rewritten in independent form.

Applicants have amended claim 31 to more particularly define the present invention.

Applicants have amended claim 40 to explicitly recite the features of independent claim 31 and to more particularly define the present invention. Applicants have amended dependent claims 41, 43, 44, 46, and 47 in conformance with the amendment to claim 40. Applicants have canceled claim 42 without prejudice.

The Examiner's claim rejections are respectfully traversed.

III. The Double Patenting Objection

The Examiner has objected to claim 42 under 37 C.F.R. § 1.75 as being a substantial duplicate of claim 41. (Office Action, p. 2, ¶ 2). In response to the Examiner's objection, applicants have canceled claim 42 without prejudice. Accordingly, the Examiner's objection to claim 42 under 37 C.F.R. § 1.75 should be withdrawn.

IV. The Section 112, Second Paragraph Rejection

Claim 40 has been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. In particular, the Examiner contends that there is insufficient antecedent basis in the claim for "the co-operating means." (Office Action, pp. 2-3, ¶ 3). Applicants respectfully disagree, and submit that the scope of claim 40 would be reasonably ascertainable by those skilled in the art. *See Ex Parte Porter*, 25 U.S.P.Q.2d 1144, 1146 (Bd. Pat. App. & Inter. 1992); *see also* MPEP § 2173.05(e). However, to facilitate prosecution of this application, applicants have amended claim 40 to recite "a co-operating means," and therefore the Examiner's rejection of the claim under section 112, second paragraph, should be withdrawn.

In connection with the rejection under section 112, second paragraph, the Examiner also states the following: "as [to] the scope of the claimed invention, claims 40-44 and 46-47 are only

treated as ‘a joining clip’ on the merits.” (Office Action, p. 3, ¶ 3). Applicants submit that, by referring to “the building element of claim 31,” claim 40 depends from claim 31, and therefore includes all the features of that claim. However, for clarity, applicants have amended claim 40 to explicitly recite the features of independent claim 31, and have rewritten claim 40 in independent form. Accordingly, the scope of amended claim 40 is “[a] building assembly comprising: a building element . . . and a joining clip.”

V. Independent Claim 31

Applicants’ amended claim 31 is directed toward a building element suitable for use as a stud or mullion. The building element of claim 31 includes a first set of three channels spaced from a second set of three channels by first and second webs, each channel in each set being substantially dimensionally similar and adapted to receive a co-operating means for the purpose of mounting a panel or bracket to the building element.

The Examiner has rejected independent claim 31 as being anticipated by Capelain, Lieber, and Schneider. The Examiner’s rejections of claim 31 under section 102 are respectfully traversed.

A. Capelain

Capelain discloses a vertical support member 3 (FIG. 6) having two spaced channels forming tracks for receiving mounting feet 21 of telescope 4 (FIG. 4). In contrast to applicants’ amended claim 31, however, the channels of Capelain are not “substantially dimensionally similar.” Rather, member 3 of Capelain has two channels that are dimensionally similar, and a third central space defined by rails 15 that is approximately four times the width of the two channels.

In addition to the failure of Capelain to show or suggest first and second sets of three “substantially dimensionally similar” channels, applicants submit that Capelain also fails to show or suggest first and second sets of three channels that are “adapted to receive a co-operating means” as recited by applicants’ claim 31. In particular, as set forth above, the inner pair of rails 15 of member 3 are spaced from each other such that the central space defined by the rails (*i.e.*, where eccentric 25 is located) is approximately four times the width of the outer channels. Thus, considering the wall height of the rails, applicants submit that it is unlikely that the rails would be suitable to receive co-operating means in the central space defined by the rails in the manner recited in claim 31. This is due to the large width-to-height ratio that would be required of any corresponding co-operating means. Thus, the central space of member 3 is not adapted to receive a co-operating means, and there is no showing or suggestion in Capelain to rebut this.

Accordingly, for at least these reasons, Capelain fails to show or suggest all the features of applicants’ amended claim 31, and therefore the rejection of the claim under section 102 should be withdrawn.

B. Lieber

Lieber discloses a partition wall having posts 1 that divide the partition into horizontally adjacent fields A, B, and C. Posts 1 include elastic strips 10 which form channels 11 (FIGS. 3A and 3B). In contrast to applicants’ amended claim 31, however, applicants submit that only central channel 11 of Lieber could receive a co-operating means, and not all three channels as recited in the claim.

In particular, applicants’ claim 31 recites that the building element is “a unitary structure.” The Examiner refers to post 1, and in particular to the portion that includes channels 11 formed by side walls 10. As clearly demonstrated in FIGS. 3A and 3B of Lieber, neither cover sheet 17 nor cover sheet 19 is connected to this element of Lieber, nor are the cover

sheets received in channels 11. Rather, cover sheets 17 and 19 are attached to junction metal profiles 15. As set forth in Lieber, on page 10, lines 10-11, the four junction profiles 15 can be fastened to post 1 in any manner. However, this description in Lieber does not agree with the illustration in FIGS. 3A and 3B, where it appears that junction metal profiles 15 are attached to cover strips 14. If cover strips 14 are regarded as being part of the stud, however, then clearly distinct structural elements are involved in engaging a co-operating means, and therefore such a building element cannot be a “unitary structure” as recited by claim 31.

Moreover, with regard to the connection between cover sheet 17 or frame cover strips 30 of Lieber and post 1, the connections are via means inserted into channels 11 of profiles 15. (*See, e.g.*, Lieber, p. 10, ll. 10-23; p. 11, l. 30 to p. 12, l. 2). Cover strips 29 of Lieber are connected to channels 11 of junction profile 15. Cover strips 30 are fastened directly to metal profile bar 25 and not to junction profile 15. Thus, applicants submit that, in contrast to claim 31, metal profiles 15 do not have a set of three channels that are “substantially dimensionally similar,” each of which is “adapted to receive a co-operating means for the purpose of mounting a panel or bracket.”

Furthermore, applicants’ claim 31 recites that “the bases of the channels in the first set of channels [are] aligned.” With respect to profiles 15 of Lieber, assuming *arguendo* that the channel for the lipped seals 13 is indeed a channel that is adapted to receive a co-operating means (which applicants submit is not the case), then there are only two channels in the “set”—channels 13 and 11. And, one set of channels 13 and 11 has the channel openings facing up in FIG. 3B, while the other set has its openings facing down. Thus, such channels do not have bases that are aligned as recited in claim 31.

Accordingly, for at least these reasons, Lieber fails to show or suggest all the features of applicants' amended claim 31, and therefore the rejection of the claim under section 102 should be withdrawn.

C. Schneider

Schneider discloses window or screen tracks incorporated in a base jamb post 36. (*See, e.g., FIG. 8A*). In contrast to applicants' amended claim 31, however, Schneider fails to disclose or suggest at least three channels that are "substantially dimensionally similar" as recited in the claim. In particular, side screen track 32 of Schneider is considerably smaller than window tracks 30 and 31.

Furthermore, tracks 30 and 31 are simple channels with linear side walls 23, 24, and 24', and are therefore not adapted to receive a co-operating means for mounting a panel or bracket on a building element as recited in applicants' claim 31. Notably, Schneider is unrelated to fixed building constructions, and therefore the reference does not disclose or suggest mounting of a panel, bracket, or any other element with which the tracks would "co-operat[e]."

Accordingly, for at least these reasons, Schneider fails to show or suggest all the features of applicants' amended claim 31, and therefore the rejection of the claim under section 102 should be withdrawn.

VI. Independent Claim 40

As described above, applicants have amended claim 40 to explicitly recite the features of independent claim 31, and have rewritten claim 40 in independent form. Accordingly, the scope of amended claim 40 is "[a] building assembly comprising: a building element . . . and a joining clip."

As set forth in applicants' Reply to Office Action filed on January 17, 2006, Miller discloses a frame for supporting a curtain wall structure, the frame including vertical frame members 16. (Miller, col. 2, ll. 46-49). As shown in FIG. 4, frame members 16 include three channels formed by base 44 and sides 46, 54, 56, and 48.

In contrast to applicants' amended claim 40, however, frame members 16 do not include a first set of three channels and a second set of three channels as recited in connection with applicants' claimed "building element." Rather, frame members 16 include only one set of channels.

Accordingly, for at least this reason, Miller fails to show or suggest all the features of applicants' amended claim 40, and therefore claim 40 is not anticipated by Miller. It follows that dependent claims 41-44 and 47, which depend from independent claim 40, are also not anticipated by Miller at least because independent claim 40 is not. Thus, the Examiner's rejections of dependent claims 41-44 and 47 are moot and should be withdrawn.

In addition, the Examiner has rejected dependent claim 46 under section 103 as being unpatentable over Miller. Applicants submit that dependent claim 46 is allowable for at least the same reasons that independent claim 40 is allowable. Furthermore, the Examiner's additional arguments with respect to claim 46 do nothing to overcome the shortcomings of Miller. Thus, the Examiner's rejection of dependent claim 46 is moot and should be withdrawn.

VII. Conclusion

Applicants respectfully submit that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicants do not concede that the cited prior art shows any of the elements recited in the claims. However, applicants have

provided specific examples of elements in the claims that are clearly not present in the cited prior art.

Applicants strongly emphasize that one reviewing the prosecution history should not interpret any of the examples applicants have described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, applicants assert that it is the combination of elements recited in each of the claims, when each claim is interpreted as a whole, which is patentable. Applicants have emphasized certain features in the claims as clearly not present in the cited references, as discussed above. However, applicants do not concede that other features in the claims are found in the prior art. Rather, for the sake of simplicity, applicants are providing examples of why the claims described above are distinguishable over the cited prior art.

Applicants wish to clarify for the record, if necessary, that the claims have been amended to expedite prosecution. Moreover, applicants reserve the right to pursue the original subject matter recited in the present claims in a continuation application.

Any narrowing amendments made to the claims in the present Reply are not to be construed as a surrender of any subject matter between the original claims and the present claims; rather merely applicants' best attempt at providing one or more definitions of what applicants believe to be suitable patent protection. In addition, the present claims provide the intended scope of protection that applicants are seeking for this application. Therefore, no estoppel should be presumed, and applicants' claims are intended to include a scope of protection under the Doctrine of Equivalents.

Further, applicants hereby retract any arguments and/or statements made during prosecution that were rejected by the Examiner during prosecution and/or that were unnecessary

to obtain allowance, and only maintain the arguments that persuaded the Examiner with respect to the allowability of the patent claims, as one of ordinary skill would understand from a review of the prosecution history. That is, applicants specifically retract statements that one of ordinary skill would recognize from reading the file history were not necessary, not used and/or were rejected by the Examiner in allowing the patent application.

For all the reasons advanced above, applicants respectfully submit that the rejections have been overcome and should be withdrawn.

For all the reasons advanced above, applicants respectfully submit that the application is in condition for allowance, and that such action is earnestly solicited.

VIII. Authorization

The Director is hereby authorized to charge any additional fees which may be required for this Reply, or credit any overpayment, to Deposit Account No. 08-0219.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Director is requested to grant a petition for that extension of time which is required to make this response timely and is hereby

authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 08-0219.

Respectfully submitted,
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